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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/613,153

Applicant(s)

FRIED, DAVID R.

Examiner

Yehdega Retta

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20, 22, 23, 32, 33, 42, 43, 52, 53, 62, 63, 72 and 73 is/are allowed.
- 6) ☒ Claim(s) 21, 24-31, 34-41, 44-51, 54-61, 64-71, 74-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

This office action is responsive to amendment filed November 3, 2003. Claims 21-23, 31-33, 41-43, 51-53, 61-63 and 71-73 have been amended. Claim 81 has been added.

Response to Arguments

Applicant's arguments filed November 3, 2003 have been fully considered but they are not persuasive.

Regarding the rejection based on 35 USC § 112, Applicant argues that the specification teaches metrics associated with corresponding company or as currently amended “at least one other selection criteria associated with performance of a corresponding company”. Applicant states that the modification is supported by the specification. Applicant also states the specification explicitly uses the term “selection criteria”. Applicant also argues that the specification does not represent the full scope of the Application's invention and as a matter of law it is improper to limit the Applicant's invention to the structures and methods disclosed in the specification.

In response to applicant argument that the modification is supported by the specification, examiner would like to refer to Applicant's specification. Applicant's specification states (see page 5), “To develop successful investment strategies, financial advisers currently rely on a myriad of theories and factors in attempt to find the best investment vehicles for their clients. These theories are often based on age-old economic trends or newly developed calculations and stock screening techniques. One such recognized value factor for predicting or analyzing company performance is the price/sales ratio”. Further states “There is, however, no single

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method that **combines the performance of the price/sales ratio with the buyback theory to maximize the performance of a stock investment portfolio.** In fact, many experts in the field **discount the importance of buyback statistics, and those recognizing its potential have not thought to combine it with a company's price/sales statistics.** Therefore, there exists **a need for an investment strategy that automatically determines those companies buying back the greatest percentage of their stock while maintaining the lowest price/sales ratio.** The result of this method should help investors develop a strategy that combines the benefits of the price/sales ratio value factor with the stock buyback theory". On page 3, the specification states that, in the preferred embodiment the selection criteria consists of a company's buyback ratio and either the price/sales ratio or the price/earnings ratio, and the selection criteria consists of price/sales ratio or price/earnings ratio.... The specification further states that **the selection criteria of the present invention, has been empirically proven to outperform other selection criteria over the same time period.** Applicant's specification does not teach other selection criteria associated with the buyback ratio beside the price/sales ratio and the price/earnings ratio.

Applicant is correct that the applicant could claim broadly, provided the claim encompasses within its scope of embodiment disclosed in the specification. However the claim as amended, "at least one other selection criteria associated with a performance of a company" is broader than what is disclosed. There are many criteria for analyzing or measuring company performance, Applicant however disclosed only two criteria associated with company performance, i.e., price/sales ratio and the price/earning ratio and the buyback ratio to screen stocks or to rank stocks. Therefore, the rejection of 35 U.S.C. 112 as stated below stays.

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Regarding the rejection based on recapture, examiner has already addressed it in the previous office actions.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 21 recites generating a report ranking a set of the identified stocks with buyback based on at least one other selection criteria associated with performance of a corresponding company. Applicant's disclosure does not teach ranking a set of the identified stocks with buyback based on at least one other selection criteria associated with performance of a corresponding company. The specification teaches ranking stocks based on the price/sales ratio or price/earning ratio for each stock (see page 2) and, on page 4, the disclosure states, the screened stocks are ranked to provide a listing satisfying the criteria inputted by the user (step 240) ... the screened stocks are ranked from lowest to highest price/sales ratio or lowest to highest price/earning ratio. Therefore the specification does not teach one ordinary skill in the art other screening criteria beside the two ratios, i.e., price/sales ratio or price/earning ratio.

Claims 31, 41, 51, 61 and 71 are rejected as stated above in claim 21.

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Claims 24-30, 34-40, 44-50, 54-60, 64-70, 74-80 are rejected since they depend on rejected claims.

Claim 81 recites selecting criteria... wherein the selected criteria consists of a buyback ratio and a company performance ratio; ranking stocks within the subset based on the company performance ratio. Applicant's disclosure does not teach ranking stocks based on company performance ratio. The specification teaches ranking stocks based on the price/sales ratio or price/earning ratio for each stock (see page 2) and, on page 4, the disclosure states, the screened stocks are ranked to provide a listing satisfying the criteria inputted by the user (step 240) ... the screened stocks are ranked from lowest to highest price/sales ratio or lowest to highest price/earning ratio. Therefore the specification does not teach one ordinary skill in the art what other ratio is used to screen or rank the stocks beside the two ratios, i.e., price/sales ratio or price/earning ratio. Selecting stocks or ranking stocks based on company performance ratio is broader than what is disclosed therefore, it is new matter.

Rejection, 35 U.S. C. 251, Recapture

2. Claims 21, 24-31, 34-41, 44-51, 54-61, 64-71, 74-81 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the

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application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

3. Regarding claims 21, 31 and 41, in the original presentation (in the patent), Applicant argued that the prior art did not disclose or suggest "selecting criteria for screening the selection of stock, wherein the selected criteria consists of a buyback ratio and at least one of price/sales ratio and a price/earning ratio for each stock" and "identifying the stocks from the specified selection having buyback ratios, wherein a buyback ratio corresponds to a percentage of issued stock repurchased from the public during a specified period and resulting in a decrease of shares outstanding". The argument constitutes an admission by applicant that the limitations were necessary to overcome the prior art. The above stated limitation of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. However, the omitted limitations were originally argued in the original application to make the application claims allowable over a rejection made in the application. Thus, the omitted limitation relates to subject matter previously surrendered, in the original application.

5. Regarding Claims 51, 61, 71 and 81, the broadening aspect of the claims is also relates to subject matter that applicant previously surrendered during the prosecution of the application. Therefore the same rejection stated above applies.

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Claims 24-30, 34-40, 44-50, 54-60, 64-70, 74-80 are rejected since they depend on rejected claims.

Allowable Subject Matter

Claims 22, 23, 32, 33, 42, 43, 52, 53, 62, 63, 72 and 73, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yehdega Retta
Examiner
Art Unit 3622

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